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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,868	01/25/2002	Thibaut Montanari *	ATOCM-245	8547

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,868

Applicant(s)

MONTANARI ET AL.

Examiner

Ana L. Woodward

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 2, 2004
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-52 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 17, 24, 25, 35-39, 50 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10, 12-16, 18-23, 26-34, 40-49 and 51 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 40, 41 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1711

DETAILED ACTION

Election/Restrictions

1. Claims 6-8, 17, 24, 25, 35-39, 50 and 52 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 15, 2003.

Claim Rejections - 35 USC § 112

2. Claims 1-5, 9, 10, 12-16, 18-23, 26-34, 40-49 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 48, the use of the term “compatabilizer”, as opposed to the art-recognized term “compatibilizer” is queried.

In claim 27, is the caprolactam defining the lactam with at least 9 carbon atoms per claim 2?

Claims 9 and 51 are duplicates claims.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 12-16, 18, 19, 22, 23, 28, 30, 33, 42, 43, 45 and 47-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 4,822,852 (Wittman et al).

Wittman et al disclose a composition comprising

(A) at least 35% by weight of a mixture of

(a) a semi-crystalline polyamide, reading on the presently claimed polyamide (A);

and

(b) a semi-crystalline or amorphous copolyamide containing

polydiorganosiloxane, reading on the presently claimed copolyamide (C),

(B) from 1 to 65% by weight of a graft product, not excluded from the present claims,

(C) from 10 to 30% by weight of an amorphous polyamide, reading on the presently claimed amorphous polyamide (B), see column 2, lines 20-45, Table 3. Particularly suitable amorphous polyamides are based on aromatic diacids and diamines (column 7, lines 53-67).

The disclosure of the reference meets the requirements of the present claims in terms of the types of materials added and their contents. The copolyamide species is immediately envisaged from the genus of two polyamides defining the reference's component (A)(b). It is reasonably believed that the products produced from the reference composition would inherently meet all the properties governing the presently claimed products since they are derived from the same composition. The onus is shifted to applicants to establish that the products of the present claims are not the same as or obvious from those set forth by the reference.

Art Unit: 1711

Claim Rejections - 35 USC § 103

6. Claims 2, 3, 5, 20, 21, 26, 27, 29, 31, 32, 34, 44, 46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,822,852 (Wittman et al), described hereinabove.

Applicants preferred species of polyamides (A) and (B) and mixtures of each would have been obvious to one having ordinary skill in the art from the general disclosure of the reference (column 5, lines 24-48, column 7, lines 33-68, etc.). The use of additional adjuvants, e.g., stabilizers, is disclosed at column 8, lines 10-15.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-5, 12-16, 18-23, 26-34, 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/416,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter with respect to the presently claimed embodiment containing component (C).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendments and Arguments

9. Applicant's amendments filed August 2, 2004 have effectively overcome the 35 U.S.C. 102 and 35 U.S.C. 103 rejections over U.S. 5,288,799 (Schmid et al) as well as the 35 U.S.C. 102 rejection over EP 0070001.

10. Applicant's arguments filed August 2, 2004 have been fully considered and are persuasive to the extent that the 35 U.S.C. 103 rejection over U.S. 5,416,172 (Blondel et al) with respect to the embodiment containing catalyzed polyamide (D) only, has been withdrawn. While it is reasonably believed that the disclosure of Blondel et al and EP '001 still render obvious the embodiment containing copolyamide (C), said rejections will not be made at this time because they are deemed redundant to the rejections set forth supra over Wittman et al, directed to similar such three polyamide containing compositions.

Allowable Subject Matter

11. The embodiment of the present claims directed containing catalyzed polyamide (D) are deemed allowable over the prior art of record.

12. Claims 9, 10, 40, 41 and 51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

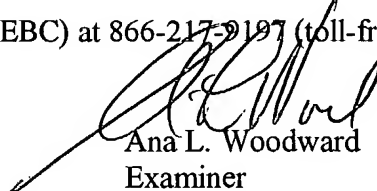
Art Unit: 1711

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Examiner
Art Unit 1711